

United States
COURT OF APPEALS
for the Ninth Circuit

HARRY X. BERGMAN, PERMA-LOX
ALUMINUM SHINGLE CORPORA-
TION, Doing Business Under the As-
sumed Name of Langville Manufac-
turing Company,

Appellants,

vs.

ALUMINUM LOCK SHINGLE CORPO-
RATION OF AMERICA,

Appellee.

PETITION FOR RE-HEARING EN BANC

*Appeal from the United States District Court for the
District of Oregon.*

FILED

JAN 9 1938

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No. 15589

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*Appeal from the United States District Court for the
District of Oregon.*

To:

The Honorable United States Court of Appeals
for the Ninth Circuit:

Appellee Aluminum Lock Shingle Corporation
of America does hereby petition this Honorable
Court for a re-hearing of the above titled cause en
banc. If the petition for re-hearing en banc is de-

nied, we respectfully petition for a re-hearing before the Court as constituted when this cause was decided.

The grounds of this petition are as follows:

- (a) The Court erred in determining that the question of the validity of the patent was, under the facts in this case, a question of law and not a question of fact.
- (b) The Court erred in failing to give effect to the provisions of **Rule 52(a) of the Federal Rules of Civil Procedure** in so far as it provides that:

“Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses.”
- (c) The Court erroneously construed the decision in the case of **Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147**, and its application to the facts in the case at bar.
- (d) The Court erroneously ignored the language of the **claim** in the patent and in placing controlling significance upon the phrase

“drain slot which forms the basis of this invention,”

 found in the description of figure 3, to the exclusion of the several elements described in the claim which, in combination, produced a new and useful unitary result.
- (e) The Court erroneously considered each element, described in the claim, separate and apart from the other elements described in the claim, instead of determining the result achieved by the combination of all of the elements as a unit.

- (f) The Court erred in refusing to give effect to the rule that a combination claim can, under the Patent Law, consist of elements "some of which may be old and others new or all old or all new," that it is "the combination that is the invention" and that "in making a combination the inventor has the whole field of mechanics to draw from."
- (g) The decision of the Court in this case, in effect, nullifies, in part, the provisions of **Section 101 of the Patent Codification Act (35 U.S.C.A., 101)**, in that it denies patent protection to a "new and useful improvement."
- (h) The Court erroneously failed to recognize that the combination claim consists of **new** as well as old elements in considering the applicability of the Great Atlantic & Pacific Tea Co. case to the case at bar.

On December 13, 1957, this Court rendered its opinion and decision in the above titled cause. The time within which to present a petition for rehearing herein will expire on January 12, 1958.

S. J. BISCHOFF,
Attorney for Appellee.

I hereby certify that in my judgment the petition for rehearing is well founded and that it is not interposed for delay.

S. J. BISCHOFF,
Attorney for Appellee.

**BRIEF IN SUPPORT OF PETITION
FOR RE-HEARING**

I

Re: Hearing En Banc

A hearing en banc is called for in this case because of the important departure from the firmly established principle heretofore subscribed to by every Judge of this Court.

The decision rendered in this case stems primarily from the rejection of the principle that the question of the validity of the patent was a question of fact.

The rejection of that principle resulted in the failure and refusal to give effect to the provisions of **Rule 52 (a) of the Federal Rules of Civil Procedure** and amounts, in legal contemplation, to a judicial repeal of that Rule in patent cases and the usurpation of the function to try patent cases de novo.

Every Judge of this Court, **including the three Judges who heard this case**, has held that the question of validity of a patent is a question of fact.

In **Stauffer v. Slenderella Systems**, decided by this Court November 15, 1957, the decision was by Judges **Barnes, Fee and Hamley**. The Court said:

“This Court has consistently held that the question of validity of a claim of a patent is one of fact.

.

“Since the findings of the trial judge were not clearly erroneous and were supported by evidence, this Court cannot set them aside.”

In **Oriental Foods v. Chun King Sales**, 244 F. 2d, 909 (9th Cir.), decided May 16, 1957, by Judges **Stephens, Fee and Barnes**, the Court held:

“This Court has only recently reaffirmed its long held position that the question of novelty and invention is one of fact as to which the conventional clearly erroneous test is applicable.”

In **Hall v. Wright**, 240 F. 2d, 787 (9th Cir.), decided January 16, 1957, the decision was by Judges **Lemmon, Chambers and Hamley**. The Court held:

“The question of novelty and invention of a patented device or method is a question of fact. *Lane-Wells Co. v. M. O. Johnston Oil Field Service Corp.*, 9 Cir., 181 F. 2d, 707. A finding of fact that the subject-matter of a patent lacks invention over the state of the prior art should therefore not be disturbed unless the finding is clearly erroneous.”

In **Schmeiser v. Thomasian**, 227 F. 2d, 875 (9th Cir.), July 27, 1955, the decision was by Judges **Stephens, Fee and Chambers**. The Court held:

“The question is one of fact. The demeanor of witnesses and appraisal of inferences to be drawn from the testimony and the supporting documents enter so largely into the determination that caution should be used by an appellate court.”

In **Jacuzzi Bros. v. Berkeley Pump Co.**, 191 F. 2d, 632 (9th Cir.), July 23, 1951, decision by Judges **Stephens, Bone and Fee**, the Court held:

“But it is contended that, since the Patent Office and the Trial Court disagreed, we should find the facts *de novo*. The assumption of such authority by the appellate court would be an **usurpation**. However, we examine the facts to determine whether the findings of the Trial Judge are clearly erroneous under Rule 52, Federal Rules of Civil Procedure, Title 28 U.S.C.A., and must set aside.

.

“True, certain of the findings were based entirely upon writings construed in the light of testimony given by experts. If the findings were based wholly on written documents without expert interpretation, the Trial Judge must find the facts and it is not true that we are in as good a position to find the facts from the written documents as he was. **Furthermore, the law does not commit that function to us, but solely the power to reverse if his findings be clearly erroneous.** Rule 52, Federal Rules of Civil Procedure.”

In *Leishman v. General Motors Corp.*, 191 F. 2d, 522 (9th Cir.), August 13, 1951, decision by Judges Biggs, Healy and Pope, the Court held (Opinion by Judge Pope):

“We think therefore that this particular finding must be held to be the result of a determination of a question of fact, which cannot be said to be clearly erroneous, and that Rule 52(a) Federal Rules of Civil Procedure, 28 U.S.C.A., prohibits us from disturbing it. ‘To no type of case is this (requirement of Rule 52(a)) more appropriately applicable than to the one before us, where the evidence is largely the **testimony of experts** as to which a trial court may be enlightened by scientific demonstrations.’ *Graver Tank & Air Products Mfg.*

Co. v. Linde Co., 336 U.S. 271, 274, 69 S.Ct. 535, 537, 93 L.Ed. 672. As well pointed out in *Hazeltine Research v. Admiral Corp.*, 7 Cir., 183 F. 2d 953, where as here, the decision turned upon questions of fact, an **appellate court is not in a position to try such fact questions de novo**. *Maulsby v. Conzevoy*, 9 Cir., 161 F. 2d 165; *Refrigeration Engineering v. York Corporation*, 9 Cir., 168 F. 2d 896." (Emphasis supplied.)

All of these decisions were rendered **subsequent** to the decision of the Supreme Court in the **Great Atlantic & Pacific Tea Co. case**. (340 U. S. 147.)

The decision in the case at bar now says that Judge Fee's statement that the question of validity was a question of fact, is erroneous. Three out of the eight Judges of this Court have decided to over-turn the long established rule that the question of validity is a question of fact notwithstanding the fact that the same three Judges have previously and very recently ruled to the contrary.

We respectfully submit that in view of this drastic change, the impact on Rule 52 (a), and because the case involves the function of the court in patent cases, the question should be considered **en banc** by all of the Judges of the Court.

The prevailing opinion cites, in support of the change the **Great Atlantic & Pacific Tea Co. case** and it quotes from the concurring opinion of Justice Douglas in which he says:

"the question of validity of a patent is a question of law."

Justice Douglas' observation in the concurring opinion does not represent the law of the case. The prevailing opinion did not subscribe to that principle. It represents only Justice Douglas' own opinion. There is nothing in the **Great Atlantic & Pacific Tea Co. case** to indicate that the Court subscribes to Justice Douglas' observation. The contrary is indicated. The Court did not over-rule or modify the ruling in the **Graver Tank & Mfg. Co. case, 336 U.S. 271**. The Court went out of its way to point out that it was not "resolving conflicting testimony," and said:

"We set aside no finding of fact as to invention, for none has been made . . ."

It is clear from this that if the decision of the lower Court had been predicated on a finding of fact, supported by evidence, the Supreme Court would not have interfered with that finding and would have adhered to the rule that the question of validity was a question of fact.

In the case at bar, Judge Fee determined the question of validity as one of fact. He made a finding of fact (No. VII, Tr. 49) in which he says that the Korter Patent

"covers a new and useful article or manufacture and a new and useful improvement thereof."

This is the test fixed by the **Patent Act (35 U.S.C.A., Sec. 101)** which authorizes the granting of a patent to anyone who

“invents or discovers any **new and useful** process, machine, **manufacture**, or composition of matter, or **any new and useful improvement thereof**,”

It is highly significant that the **Patent Act** was amended and codified July 19, 1952, two years after the **Great Atlantic & Pacific Tea Co. case** was decided. Notwithstanding the criticism of Justice Douglas in his concurring opinion as to the granting of patents on so-called “gadgets,” the Congress did not see fit to limit or restrict the granting of patents within the narrow limits of Justice Douglas’ views. The Congress not only re-enacted Section 101 (except for the substitution of the word “process” for the word “art”), but it created, for the first time, a **statutory presumption of validity**. (**35 U.S.C.A., Sec. 282.**)

While a presumption of validity was indulged prior to the enactment of the statute, the effect of that presumption had been practically emasculated by a series of decisions and the Congress saw fit to create the statutory presumption to give greater stability to patents issued by the Patent Office.

The case at bar comes squarely within the purview of the **Jacuzzi case**, supra, because Judge Fee did not render his decision merely from a reading of the Korter Patent in juxtaposition to other patents. He found that the invention produced a new and useful improvement in the art of metal shingles, as a result of **expert testimony** which en-

abled him to understand and appreciate the inter-relation of each of the elements to each other and the result achieved by the design of each element, the inter-dependence of one upon the other, the sequence of functions which produced the ultimate result of diverting the condensation water from the under-side of the shingles to the outside. Judge Fee heard the testimony of the parties. He heard their descriptions. He heard their explanation of the functions. He heard the expert testimony pro and con and from that evidence, he found the existence of a new and useful unitary result. That involved a question of fact.

The decision rendered in this case, if allowed to stand, results, in effect, in:

- (a) Repealing **Rule 52(a)** in Patent Cases; and
- (b) The usurpation of a function by the Court, namely, the trial of issues de novo instead of reviewing a judgment to determine whether it is clearly erroneous within the purview of **Rule 52(a)** of the **Federal Rules of Civil Procedure**.

We respectfully submit that before such a drastic change in the law is made, all of the Judges of this Court should examine and pass upon the questions involved.

II

The Court erroneously determined the scope of the patent by giving controlling significance to a phrase appearing in the description of one of the drawings instead of determining the scope of the patent and the effect of the combination from the language of the claim in its entirety.

The Court seized upon a phrase appearing in the description of figure 3 of the drawing which says:

“Fig. 3 is a fragmentary perspective view of one corner of the shingle showing the drain slot which forms the basis of this invention.”

This is not the language of the claim. It is the language which describes one of the several drawings which are a part of the specifications.

The purpose and scope of the patent must be determined from the language of the **claim** and not from an isolated word or phrase appearing in the specifications or description of the drawings.

In *Milcor Steel Co. v. George A. Fuller Co.*, 316 U.S. 143, the Supreme Court said:

“As the courts below pointed out, it is these claims, not the specifications, that afford the measure of the grant to the patentee.”

In 69 C. J. S., 706, Sec. 205, the text says:

“Drawings assist, but do not control, in construing the claims of a patent. . . .”

“The claims cannot be . . . limited, or their meaning varied, by reference to drawings. . . .”

“If an ambiguity is created because of differences between the specifications and claims and the drawings, it is the duty of the court to resolve it in favor of the patentee.”

The drawing, referred to as “Figure 3,” merely describes **one of the several elements** that enter into the combination. That particular element (drain slot) is, of course, important **in the combination**. But, in and of itself, is of no value or importance. It is the basis of the invention only insofar as it represents the point at which the condensation water is discharged from the under-side of the shingles to the outside, not by virtue of its own function, but by virtue of all of the other elements in combination which operate to bring the condensation water to that drain slot. Without those elements in combination to insure the channeling of the water to the drain slot, the drain slot itself would be of no value and nothing was ever claimed for it as such.

The claim itself is not limited to a description of a drain slot. The claim, which is fully set forth in the Opinion, enumerates a number of elements, each one of which performs a distinct function which leads to the next succeeding element, **all designed to insure that the condensation water will reach the drain slot**. The Opinion bears every evidence that the Court adopted the language descriptive of Figure 3 (not found in the claim) and ignored or rejected the language of the claim descriptive of all of the elements forming the com-

bination and showing their inter-dependence and the result accomplished thereby. All of this is ignored.

While some of the elements, described in the claim, may be old, **there are elements in the claim that are new** which are essential to the accomplishment of the purpose of the invention.

Take, for example, the grooves 12, shown in Figure 6. There were other shingles that had grooves in them. But the grooves in the Korter Patent were designedly made so that the indentation is **downward** instead of upward (as in the Miller patent). The grooves were not introduced for ornamental purposes and were not placed downward for ornamental purposes. The indentation of the grooves was **purposely made downward** and to **extend the full length of the shingle** so that it could **act as a leg** resting on the next lower shingle and **thereby maintain a space along the length of the shingle** through which the condensation water could drain into the gutter and from the gutter to the drain slot. **Without that leg, the shingle would lay flat on the next lower shingle without any space for the condensation to draw** which would **defeat** the ultimate purpose of the entire invention. This element is but one of a number of elements introduced and so arranged as to insure the drainage of the condensation to the drain slot. It forms part of the combination. It was new and made it possible for the combination to produce the desired result.

There is no comparable element in any of the several patents. The grooves shown in Miller are on the “upper side” and not for the full length of the shingles. They do not act as legs to create spacing. They serve no useful purpose other than that of ornamentation. The Miller patent says that the ridge is to

“strengthen the shingle so that relatively long shingles can be easily handled, and these ridges are so spaced on the upper and lower halves of each shingle as to divide the shingle into a plurality of panels . . . producing a random effect which is desirable from an architectural point of view.”

They do not and cannot contribute to the function of insuring drainage of the condensation water from the under-side of the shingle into the gutter.

The Court seems to have over-looked the interdependence of each of these elements and the purpose sought to be accomplished thereby and this led to the conclusion that the drain slot was the sole purpose of the invention and not the combination of the elements (new and old) which insured drainage to the drain slot.

In concluding that the drain slot was the sole purpose of the invention, the Court ignored principles firmly established.

In *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U.S., 325—29 S. Ct., 503, the Court held:

“A combination is a composition of elements, some of which may be old and other new, or

all old or all new. It is, however, the **combination** that is the invention, and **is as much a unit** in contemplation of law as a single or non-composite instrument." (Emphasis supplied.)

In **Diamond Rubber Co. v. Consolidated Rubber Tire Co.**, 220 U.S. 428, 31 S.Ct., 444, the Court held:

" . . . the elements of a combination may be all old. In making a combination the inventor has the whole field of mechanics to draw from."

These principles were recognized as late as July 17, 1957, in the case of **Long v. Arkansas Foundry Co.**, 247 F. 2d, 366.

III

The Court committed basic and fundamental error when it ruled

"we find that, considered together, in one respect or another they (patents relied on by appellants) anticipate the patent in suit."

This method of determining the validity of the patent is diametrically opposed to the decisions of the Supreme Court of the United States, and of this Court and the Courts of all other Circuits, which established the rule that the validity of a combination patent is **not to be determined by the presence of one or another of the elements in different patents.** Anticipation can only be determined by reference to **another combination patent containing all of the elements involved in the patent**

under consideration. That is the teaching of all of the cases cited above.

In **Jacuzzi Bros. v. Berkeley Pump Co., 191 F. 2d, 632** (9th Cir.), the Court held:

“A true **combination** which performed a new function necessarily **must be found as a whole** in a prior patent or publication in order to accomplish destruction of a grant of monopoly. *Imhaeuser v. Buerk*, 101 U.S. 647, 660, 25 L. Ed., 945; *Adams v. Bellaire Stamping Co.*, 141 U.S. 539, 542, 12 S.Ct. 66, 35 L.Ed. 849.” (Emphasis supplied.)

In **Refrigeration Engineering v. York Corp., 168 F. 2d, 896** (9th Cir.), the Court held that

“‘the law’ . . . looks only to the combination itself as a **unit distinct from its parts.**” (Emphasis supplied.)

In **Crowell v. Baker Oil Tools, 153 F. 2d, 972** (9th Cir.), the Court held:

“As the appellant aptly claims, to anticipate such a combination, it is necessary to find in the prior art **the same combination having the same steps or their equivalents.** It is not enough that one find in the prior art similar steps **here and there**, because the inventive genius consists in picking out and combining old steps or inventing new ones for use in a new combination. Given a new and useful combination of steps (old or new or both), the patentability of the process depends exclusively upon the quality of skill or genius involved in the combination and its results.” (Emphasis supplied.)

The decision in this case shows clearly that it was arrived at by finding (erroneously, as we be-

lieve) one element in one patent and another element in another patent instead of examining the prior art for a patent combining all of the elements (new and old) present in the Korter Patent.

IV

The Court over-looked entirely the important fact that the draining of condensation water from the under-side of metal shingles was not the object or purpose of any patent brought to the attention of the Court (either in a combination claim or in separate claims), and that the Korter Patent is the only one that dealt with the problem and devised the means of draining the condensation.

The Court has ignored the important fact that none of the patents referred to by the Appellant dealt with the problem of eliminating condensation water from the under-side of metal shingles.

The subject is not even mentioned in any of the patents except the Belding Patent and that Patent did not attempt to solve the condensation problem by draining the water from the under-side to the outside of the roof, but sought to **prevent the formation of condensation** by introducing ventilation.

In the case at bar, we have an Inventor who recognized an important serious problem affecting metal shingles. Belding recognized it as a serious problem and Korter undertook to devise a means

of draining off the condensation water. He dealt with a serious problem which no one had attempted to solve. He solved it by the development of the combination of elements described in the claim. The problem sought to be solved is a most important factor in determining whether the invention was "a new and useful improvement" within the meaning of **Section 101 of the Patent Act.**

The Court points to the fact that the patent also expresses, as one of its purposes, the draining of rain water that might seep into the roof. But we know of no decision, and none was cited in Appellants' Brief, or in the Opinion, which invalidates a patent because it can serve another purpose besides the one which is "a new and useful improvement."

An improvement that would merely provide for run-off of rain water would have no relevancy to the important problem of draining off condensation that forms on the under-side of the shingle to the outside of the roof.

V

Re Application of Great Atlantic & Pacific Tea Co. Case

The **Great Atlantic & Pacific Tea Co.** case focuses attention on the principles:

- (a) that the combination must perform or produce a new or different function or operation;

- (b) the combination of “**known** elements must contribute something;” and
- (c) that the exacting standard of invention is applied only to a combination “**made up entirely of old components.**”

The concluding sentence is of the utmost importance. The Court says:

“It is on this ground that the judgment below is reversed.”

The decision was expressly made applicable only to a combination made up **entirely** of old **elements**.

There is no intimation in the decision that the decision was to be made applicable to a combination made up in part of old elements and the introduction of new elements.

The Korter Patent meets all of the standards of invention required by the **Great Atlantic & Pacific Tea Co. case**.

- (a) The **combination** performs a “new or different function than theretofore performed by any other combination of elements.”

The new function that was introduced by the Korter Patent to the use of metal roof shingles was to provide a system of draining condensation water from the under-side of the shingle to the outside of the roof. This is the primary function of the invention. This function was not dealt with or even considered or mentioned in any patent, whether of a combination or a series of separate claims, except

the Belding Patent which merely recognized the problem, but attempted to solve it in a different manner, to-wit, by the introduction of ventilation to prevent formation of condensation and not the draining of condensation when formed.

(b) The combination did "contribute something."

The Korter invention "contributed something" to the usefulness of metal roofing shingles which "something" exceeded the functions performed by other shingles because none of the shingles, brought to the attention of the Court, attempted to solve the problem of draining the condensation water.

None of the elements shown in the prior patents individually or collectively performed this important function.

(c) The combination did not consist **entirely** of **old** elements. It was a combination of **new** and old elements that performed the new function.

The Korter Patent introduced new elements which, in combination with old elements, produced the new and useful unitary result.

The most important **new** element included in the combination was the

"corrugations in said shingle spaced laterally of the shingle, said corrugations forming ridges on the **inner face** of the **shingle.**" (Lines 38 to 41, Column 2)

as illustrated by Figure 6, and

“said corrugation ridges on the **inner face** of the shingle **adapted to space** said reversely turned top edge portion of the lower adjacent shingle **from the inner face** of said shingle so **that moisture can travel along the inner face of the shingle and into said gutter.**” (Lines 5 to 10, Column 3, illustrated by Figure 6.)

The Court has entirely over-looked the significance and importance of this element and the part that it plays in insuring the drainage of the condensation from the **inner** surface of the shingle into the gutter. The importance of this element does not lie merely in the fact that the shingle has a ridge or groove. It lies in the fact:

- (a) that the ridge or groove was indented downward “to the inner face” **to form legs or risers** and **not upward** on the “upper side” of the shingle as in the Miller shingle; and
- (b) the ridge or groove was extended along the entire surface of the shingle so that the lower end (legs) of the groove would rest on the upper edge of the lower shingle.

The groove, or corrugation, being deeper than the corrugations along the face of the shingle, **insured** a **space** through which the condensation water could drain into the gutter, whereas, in the absence of the downward corrugation, **which formed the leg**, the shingle would lay flat along the edge of the lower shingle blocking the drainage from entering the gutter. **This is the heart of the invention and the function that this element performs** was over-looked by the Court.

The Court points to the Miller Patent as having comparable ridges or grooves.

There is a vast and fundamental difference between the ridges in the Miller Patent and the ridges in the Korter Patent.

The Opinion **incorrectly** describes the corrugations in the Miller Patent. It says (Opinion, p. 7) that the Miller Patent

“calls for a shingle with transverse ridges, which are comparable to the appellee’s ‘corrugations’,”

and then goes on to say,

“‘said corrugations forming ridges on the **inner face** of the shingle’.”

This latter statement is erroneous. The Miller Patent nowhere describes ridges formed on the **inner face** of the shingle. Throughout the Miller Patent, at every step and in each of the claims, the ridge is described as being on the **“upper sides.”** The phrase “upper sides” is used in describing the ridge wherever it is referred to through the specifications, drawings and in the claims. The drawings also show that the ridges, **instead of running from top to bottom so that the ends could form legs** to insure spacing, shows that the ridges were not designed to extend to the top or bottom, but ended a substantial distance from the top and bottom. This erroneous description of the ridges in the Miller Patent indicates clearly that the Court did not appreciate the significance and purpose of the

ridges in the Korter Patent and why they were intentionally placed on the "inner side" of the shingle to form legs, instead of being placed on the outer side for design purpose only to simulate separate shingles and to "strengthen" the shingle. (Line 21, Column 1.)

The ridges in the Miller shingle were not designed to and cannot perform the important function of **maintaining space between the upper and lower shingle so that the condensation could flow into the gutter.** There is, of course, a vast difference between a corrugation introduced for the purpose of ornamentation, or appearance, or to strengthen the metal and the introduction of ridges designed in such a way as to perform an important essential function without which the purpose of the combination would be defeated or impossible of accomplishment.

No patent, brought to the attention of the Court, included the element of corrugations faced downward and extending to the bottom of the shingle to form a leg to insure spacing through which condensation could flow into the gutter.

We sincerely believe that this erroneous concept of the corrugation in the Miller Patent and the failure to appreciate the true purpose of the corrugations in the Korter Patent, led to the conclusion arrived at in this case.

Since the Korter Patent introduced new elements and does **not consist entirely of a combina-**

